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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,457	12/11/2000	Toshiaki Ozasa	P/1071-1245 (DIV)	4365

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07/01/2003

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EXAMINER

MITCHELL, JAMES M

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

09/734,457

## Applicant(s)

OZASA, TOSHIAKI

## Examiner

James Mitchell

## Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 7-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Honma (JP3296205A).

Honma (Fig 3) discloses a ceramic electronic component (Title) comprising a chip of an electronic component ("capacitor") containing inner wiring (2) and at least one terminal electrode on an outer surface of the electronic component (23), a second layer (25) on the outside of the first layer and a third layer on the outside of the second layer and wherein the second layer is inherently porous (via space filled with conductive particles, 24); with two of said electrodes disposed at different sites on the outer surface of the electronic component.

With respect to claim 3, a baked conductive particle is a method of making characteristic that is given no patentable weight in determining patentability of the final device structure. Note that a "product by process" claim is directed to the product per se, no matter how actually made. *In re Thorpe*, 227 USPQ 964. Case law makes it is clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, not the patentability of the process, and that an old or

obvious product produced by a new method is not a patentable product, whether claimed in "product by process" or not.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Honma as applied to claims 2 or 3.

Honma further includes an inherent size of its conductive particles, but does not appear to explicitly disclose that the conductive particles have a size of 0.5 to 2 micrometers.

However, absent evidence of criticality, it would have been obvious to one of ordinary skill in the art to form the conductive particles at a size of 0.5 to 2 micrometers, because it has been held that:

Where the only difference between the prior art and the claim was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently the prior art device, the claimed device was not patentable distinct from the prior art device.

In *Gardner v TEC Systems, Inc.*, 725 F. 2d 1338, 220 USPQ 777 (Fed Cir. 1984).

In regards to claim 4, the process of forming an adhesive has no patentable weight, since this is a product by process claim.

Claims 6 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma in combination with Sakabe (US 4,658,328).

Honma further inherently discloses a method for producing a chip of ceramic electronic component having inner wiring electrically connected to a terminal electrode on the outer surface of the electronic component comprising the steps of inherently providing said electronic having inner wiring, forming a first paste film ("layer"; English Abstract) and forming at the side of first layer a second conductive layer containing inherent conductive particles and forming a third conductive layer containing inherent conductive particles.

Honma does not appear to disclose baking paste layers or adding an additive.

However Sakbe teaches baking (Col.1, Lines 39-40) first and then second paste layers with an additive to it layer (Col. 1, Lines 40-41).

It would have been obvious to one of ordinary skill in the art to incorporate baking paste layer of Honma by incorporating an additive and baking in order to form electrodes as taught by Sakabe (Col. 1, Lines 39-40).

With respect to claims and 16-18, absent evidence of criticality, it would have been obvious to one of ordinary skill in the art to form the conductive particles at a size of 0.5 to 2 and 3 to 6 micrometers, because it has been held that:

Where the only difference between the prior art and the claim was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently the prior art device, the claimed device was not patentable distinct from the prior art device.

In Gardner v TEC Systems, Inc, 725 F. 2d 1338, 220 USPQ 777 (Fed Cir. 1984).

With respect to claim 19, Sakebe teaches baking a layer, which inherently undergoes a dried phase and then adding and baking a second layer, the process of a dried second conductive and then simultaneously baking second and third conductive paste would have been obvious matter of design choice to one of ordinary skill in the art bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose the particular claimed sequence because applicant has not disclosed that the limitation is for a particular unobvious purpose, produces an unexpected result, or is otherwise critical, *Ex parte Rubin* 128 USPQ (PO BdPatApp 1959).

***Allowable Subject Matter***

Claims 7-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose or make obvious adjusting the content of additive to obtain a predetermined void ratio including all the limitations set for the in the independent claim.

***Conclusion in the second conductive past to obtain***

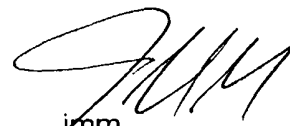
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mitchell whose telephone number is (703) 305-0244. The examiner can normally be reached on M-F 10:30-8:00.

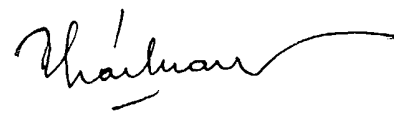
Application/Control Number: 09/734,457  
Art Unit: 2827

Page 6

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (703) 305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-3230 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
jmm  
June 16, 2003

  
Luau Thai